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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/030,692 | 01/14/2002 | Hans Rudolf Muller | EPROV 17 | 8615 |
| 23599 7590 03/26/2010 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201 | | | | |
| EXAMINER | | | | |
| BERCH, MARK L. | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 1624 | | | | |
| NOTIFICATION DATE | | DELIVERY MODE | | |
| 03/26/2010 | | ELECTRONIC | | |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

Office Action Summary

Application No.

10/030,692

Applicant(s)

MULLER ET AL.

Examiner

Mark L. Berch

Art Unit

1624

Period for Reply -- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 29, 33, 34, 40, 45-49 and 51-57 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-13, 29, 33, 34, 40 and 45-49 is/are allowed.
- 6) ☒ Claim(s) 14 and 51-57 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 51-57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. In the definition of the divalent radical R6, applicants have replaced the original choice: “methylene-4-pyrrolidine-4-yl” with the new choice “2-methylene-4-pyrrolydinyl”. This is problematic because:

- a. The letter “y” has replaced “i” between the l and d. This may be a typo.
- b. This is a divalent radical, but it has been written as a monovalent choice, ending with -yl.

It should end with ...ene (see previous or following choices). Instead, it has a methylene group, i.e. =CH₂, at the 4-position of the pyrrolidine, which is itself bonded at the 4-position. As a divalent radical, it conveys being the divalent methylene group, with the pyrrolidinyl pendant. Naming divalent groups with cyclic and non-cyclic components is difficult. Applicants can use the formula. Or applicants can use: “the divalent radical formed by removal from 2-methyl-pyrrolidine of H from the methyl group, and H from the 4-position of pyrrolidine.” Either would be unambiguous and convey what structure XXXIV has.

B. In the R28 and R6 definition there appears C₁-C₈ acyl as a substituent. In carboxylic acid acyls, does the carbon count include the carbon of the carbonyl? That is, would this or would this not include H-C(O)- and C₈H₁₇C(O)-? The traverse is unpersuasive. Applicants have opted to go with a definition that does not have H, and hence H-C(O)- is not included

Art Unit: 1624

but $\text{C}_8\text{H}_{17}\text{C}(\text{O})\cdot$ is included. This is arbitrary. For example "Acyl" Hawley's Condensed Chemical Dictionary, 14th Edition Copyright ©2002 downloaded from the internet 3/23/2010 says (see second sheet) it is derived from "an Organic acid...", which would cover $\text{R}=\text{H}$, since formic acid is an organic acid. Similarly, the reference "Acyl" Dorland's Medical Dictionary downloaded from the internet 3/23/2010 also simply says "an organic acid". The reference HACKH'S CHEMICAL DICTIONARY (American and British usage) Revised and edited by Julius Grant. Third Edition. The Blakiston Company, Philadelphia, 1944, page 18 has the same "organic acid" language. In the reference "Acyl From Wikipedia, the free encyclopedia" downloaded from the internet 3/23/2010, see the table on the second page, in which formyl is the first choice. Other references could be provided as well. Thus, the decision to exclude $\text{H}\cdot\text{C}(\text{O})\cdot$ but include $\text{C}_8\text{H}_{17}\text{C}(\text{O})\cdot$ (rather than vice versa) is completely arbitrary.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action.

In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark L. Berch whose telephone number is 571-272-0663. The examiner can normally be reached on M-F 7:15 - 3:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James O. Wilson can be reached on (571)272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Mark L. Berch/
Primary Examiner, Art Unit 1624

3/25/2010